

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Applicant notes for the record that this application has now undergone **FIVE NON-FINAL OFFICE ACTIONS** starting with the action of June 1, 2004, each of which has been successfully overcome without need to amend the claims, but which has later been subjected to a further rejection. Moreover, this application has now been pending for almost five years. Applicant submits that this is clearly contrary to compact prosecution and is furthermore non-productive and needlessly costly to the USPTO and to the undersigned's client. Furthermore, such rolling rejections further aggravate the already extensive backlog of cases in the USPTO and increase pendency. By this point in prosecution (in fact, long before this point), either the application should have been allowed or an issue should have been solidified to the point that resolution by appeal is appropriate. Applicant further notes that this application received a favorable patentability opinion in the International Application made under the Patent Cooperation Treaty, dated 2/10/2003 (from Mr. Trammell), which was previously submitted in an IDS. Applicant wishes to bring prosecution to a conclusion at the earliest possible time and requests that the Examiner and her SPE or Group Director contact the undersigned by telephone upon review of this response to expedite closure of all issues in this matter to avoid the necessity of appeal or petition.

Regarding the Rejections under 35 U.S.C. §112 Second Paragraph

Claims 1-28 were rejected as indefinite for use of the terms "may" and "wishes". Applicant notes that between 1/1/1976 and 4/5/2006, 762 U.S. patents issued using the term "wishes" and 230,617 patents issued using the term "may" in the claims. Clearly, use of these terms alone does not render a patent claim indefinite. Moreover, the present claims were not considered indefinite in any of the four prior office actions, and the use of these terms is believed clear and definite. Hence, Applicant disputes that there exists any issue of indefiniteness in the present claims.

Application No.: 09/836,631

That notwithstanding, Applicant has amended the claims to remove the instances of the terms "may" and "wishes" in order to eliminate the language to which the Examiner objects, thereby rendering the issue moot. In view of the above observations regarding the words "may" and "wishes", however, it is clear that such amendments are non-substantive and are intended to have no impact on the scope whatsoever. These amendments are not being made for any purpose relating to patentability. Rather, the amendments are being made to eliminate a point of contention in order to remove this issue in the spirit of cooperation. If the Examiner believes that the scope of any claim has been altered in any way by this amendment, it is respectfully requested that this be brought to the attention of the undersigned in order to assure that corrections are made. The claims as amended to eliminate these terms should be interpreted the same as if they had remained unamended.

In addition to these amendments, the term "is" has been changed to "comprises" in order to assure that the term is interpreted as open ended in the claims. One new claim is presented for the Examiner's consideration. Additionally, the term "algorithm" as in "digital rights management algorithm" has been removed from the claims, since digital rights management is a well understood function that may entail more or less than an algorithm, *per se*. These amendments should not be interpreted as narrowing. Additionally, several claim dependencies have been amended to enhance the breadth of certain of the dependent claims.

Regarding the Rejections under 35 U.S.C. §103(a)

Regarding the Fritsch reference, the Office Action admits, and Applicant agrees, that Fritsch fails to disclose having a consumer choose among format options, etc. (paragraph 5 of the present Office Action). However, the Office Action alleges that this teaching is present in Silverbrook (6,459,495) at col. 346, lines 47-51. It is noted that the cited Silverbrook patent appears to have no column 346 (it appears to end at 294 columns), but the undersigned has electronically searched Silverbrook for the alleged disclosure and is unable to find it. A search for relevant terms used in the claims (e.g., download, DRM, digital rights management, digital rights, rights, portable, portable devices, compression format, downloadable digital data, etc.)

Application No.: 09/836,631

finds no information relevant to the present claims. In view of the above, and the fact that Silverbrook relates to an ink dot centering technology, it is submitted that Silverbrook in fact fails to provide the disclosure alleged in the Office Action.

In addition, Silverbrook is clearly non-analogous art under MPEP 2141.01(a) which states:

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

In reviewing Silverbrook, Applicant finds no teaching or suggestion of anything which is either a) in the field of Applicant's endeavor, or b) reasonably pertinent to the problem addressed in Applicant's claims because Silverbrook appears to be concerned with converting scanned images and apparently fails to even provide the disclosure alleged in the Office Action. Applicant further finds no reason whatsoever to look to the Silverbrook reference for any guidance relating to the present invention.

Application No.: 09/836,631

The Office Action further asserts that Dwek's disclosure relating to creation of and editing user-defined channels is relevant to the claims, citing edit button 392 and the text of col. 10, lines 60-66 as indicative that the user can edit the musical format of the user defined channel. The basis for this assertion takes Dwek's teachings out of context. Dwek relates to a mechanism for creation of "user defined channels" which are analogous to radio stations to provide a continuous stream of music (col. 9, lines 62-65). Column 10, lines 4-34 and col. 11, lines 5-16 further clarify that a "channel" is a merely a collection of songs (e.g., associated with a user, a preference or a musical theme). Dwek further states at col. 7, lines 55 through 62 that the music player can preferably play music in multiple formats, but makes no suggestion of a user selecting a compression format. As best can be determined by the undersigned, Dwek contributes nothing relevant to the present claims.

The Office Action provides as a motivation to combine the references to be "in order to obtain greater ease and security in data transaction". This statement amounts to a broad conclusory reason about generalized advantages. More is required than a statement that one could "obtain greater ease and security in data transaction" and that it would have been obvious to modify the primary references to bring about this function. In re Dembiczak, 175 F.3D 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (the range of sources available does not diminish the requirement for **actual evidence**, and "broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence")[†] (emphasis added). In view of the clear lack of evidence, there is no motivation to make the proposed combination.

In view of all of the above, the proposed combination clearly falls short of establishing *prima facie* obviousness of claim 1. Reconsideration and allowance are respectfully requested.

Regarding claims 2-6, the above remarks are equally applicable. In addition, the undersigned finds it interesting that the asserted disclosure of four lines of text from one column

[†] Dembicza was recently cited in In re Beasley, Civ. App. 04-1225, slip op. at 6-7, 2004 WL 2793170 (Fed. Cir. Dec. 7, 2004, non-precedential), which stated "Conclusory statements, of generalized advantages and convenient assumptions about skilled artisans ... are inadequate to support motivation ...".

of Silverbrook is alleged to disclose more than twenty eight lines of claim language as recited in the office action in section 7 thereof.

Regarding claims 9-14, the above remarks are equally applicable. Also, although Fritsch briefly discusses downloadable format at the cited passage, there is no disclosure of selection, download, or storage of type of software, compression format, DRM algorithm or type of portable device. Moreover, there is no discussion of SDMI. Accordingly, it is believed that there is no adequate disclosure to obviate the claim.

Claims 15-28 are indicated to be rejected under the same terms as claims 1-14. Hence, the rejection is fatally flawed for the reasons enumerated above.

The Examiner has implied in the note in paragraph 17 (as in prior office actions) that Applicant should review the entire references and not restrict comments to the specific citations of column and line. Applicant has attempted to do so to the extent reasonable, but Applicant wishes to remind the Examiner of the requirements of 37 CFR 1.104(c)(2) in this regard. In particular, it is noted that the Silverbrook reference is some 288 pages in length. Hence, it has been reviewed manually to a reasonable extent and searched electronically.

Concluding Remarks

It is again noted that this is a FIFTH non-final action in this case. It is further submitted that PAIR indicates that multiple searches have been carried out without establishing *prima facie* obviousness in any of the actions. Accordingly, Applicant submits that this application should be promptly passed to allowance.

In view of this communication, all claims are believed to clearly be in condition for allowance. Accordingly, reconsideration of all claims and allowance are respectfully requested at an early date. The undersigned reiterates the request that the Examiner and her SPE or Group Director contact the undersigned to resolve final issues in this case and pass it to issue. The

Application No.: 09/836,631

undersigned can be reached at the telephone number below.

Respectfully submitted,



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Dated: April 6, 2006

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Application No.: 09/836,631

-16-